

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Patrizia PATERLINI-BRECHOT

Patent No.: 7,651,838 B2

Confirmation No.: 7652

Issued: January 26, 2010

Art Unit: 1634

For: PRENATAL DIAGNOSIS METHOD ON
ISOLATED FOETAL CELL OF MATERNAL
BLOOD

Examiner: C. J. Myers

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

UNDER 37 CFR § 1.705 (d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to CFR § 1.705 (d), and in response to the Decision on Petition dated December 3, 2009, Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) indicated on the Issue Notification for Patent No. 7,651,838 B2 (Exhibit 1). The Issue Notification indicates that the PTA is 0 days. However, Patentee submits that the PTA should correctly be 104 days.

STATEMENT OF FACTS

1. The Issue Notification, which issued in this case on January 6, 2010, indicated that the PTA to date was 0 days.
2. The U.S. Patent and Trademark Office's PTA History, as found in the Patent Application Information Retrieval (PAIR) system, indicates a PTA due to

Patent No. 7,651,838 B2
Request for Reconsideration of Patent Term Adjustment

prosecution delays of 0 days, based upon 334 days of USPTO delays minus 498 days of Applicant delay (see Exhibit 2).

3. However, the PAIR system does not indicate any PTA due to the USPTO's failure to issue a patent within three (3) years (36 months) from the actual filing date of the application, October 20, 2003 (37 C.F.R. § 1.702(b)), which delay was 148 days.
4. Patentee contends that the exclusion period for the appeal process should not be applied to this case since a Request for Reconsideration was filed on March 28, 2007 removing the case from the appeal process.
5. Additionally, the USPTO incorrectly debited PTA days for the filing of drawings on July 16, 2009. As is indicated on the copy of the drawing scanned in on the PALM system on July 16, 2009, the drawing was received by date stamped as received on August 13, 2004 (see Exhibit 3). Patentee did not file the sheet of drawings, but rather it appears the USPTO scanned this document into the PALM system on this date. Therefore, Patentee should not have been debited 120 PTA days for the filing of the drawing sheet. Patentee further submits that this issue is being timely addressed since this 120 day debit was not indicated in the U.S. Patent and Trademark Office's PTA History submitted with the August 27, 2009, PTA Petition, (Exhibit 4).
6. In accordance with the recent District Court decision in *Wyeth et al. v. Kappos*, (United State Court of Appeals for the Federal Circuit (2009-1120)), the correct PTA should be 482 days of PTO Prosecution delay, less 378 days of applicant delay, for a total of 104 days of PTA.
7. Accordingly, Patentee hereby requests that the U. S. Patent and Trademark Office correct the calculation of the PTA for the above-identified patent to 104 days.

**COMPLIANCE WITH REQUIREMENTS OF
37 CFR § 1.705 (b)(1) AND (2)**

8. A statement of facts is presented above, detailing the relevant dates and the correct PTA.
9. The present application is not subject to any Terminal Disclaimer or any expiration date specified in a Terminal Disclaimer (§ 1.705(b)(2)(iii)).
10. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified application (§ 1.705(iv)(B)).

CONCLUSION

The USPTO is requested to correctly indicate that U.S. Patent No. 7,651,838 B2 is entitled to 104 days of Patent Term Adjustment.

PAYMENT OF FEES

As set forth in the attached Fee Transmittal, the Commissioner is hereby authorized to charge the amount of \$200.00 to Deposit Account No. 02-2448 for the consideration of this Request as required by 37 C.F.R. § 1.18(e).

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr., Reg. No. 28,977 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/695,744
Amendment dated August 26, 2009
After Allowance Under 37 C.F.R. 1.312


Docket No.: 2121-0178P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated:

MAR 25 2010

Respectfully submitted,

By 

Gerald M. Murphy, Jr.

Registration No.: 28,977

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(703) 205-8000

Attorney for Applicant

Attachments:

Issue Notification, (Exhibit 1)

U.S. PTO PAIR PTA Calculation, (Exhibit 2)

Copy of drawing sheet from U.S. PTO PAIR, (Exhibit 3)

U.S. PTO PAIR PTA Calculation dated July 30, 2009, (Exhibit 4)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | ISSUE DATE | PATENT NO. | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|------------|------------|---------------------|------------------|
| 10/695,744 | 01/26/2010 | 7651838 | 2121-0178P | 7652 |

2292 7590 01/06/2010
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 0 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Patrizia Paterlini-Brechot, Paris, FRANCE;

| | | |
|------------|---|----------------------|
| 10/695,744 | PRENATAL DIAGNOSIS METHOD ON ISOLATED FOETAL CELL OF MATERNAL BLOOD | 03-25-2010::10:44:14 |
|------------|---|----------------------|

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/695,744

| | | | |
|------------------------------|------------|--------------------------------------|---|
| Filing or 371(c) Date: | 10-30-2003 | USPTO Delay (PTO) Delay (days): | - |
| Issue Date of Patent: | 01-26-2010 | Three Years: | - |
| Pre-Issue Petitions (days): | - | Applicant Delay (APPL) Delay (days): | - |
| Post-Issue Petitions (days): | - | Total PTA (days): | 0 |
| USPTO Adjustment(days): | - | Explanation Of Calculations | |

Patent Term Adjustment History

| Date | Contents Description | PTO(Days) | APPL(Days) |
|------------|---|-----------|------------|
| 01-06-2010 | PTA 36 Months | | |
| 01-26-2010 | Patent Issue Date Used in PTA Calculation | 29 | |
| 12-08-2009 | Dispatch to FDC | ⬆ | |
| 12-08-2009 | Dispatch to FDC | ⬆ | |
| 12-08-2009 | Email Notification | ⬆ | |
| 12-03-2009 | Mail-Petition Decision - Dismissed | ⬆ | |
| 12-02-2009 | Petition Decision - Dismissed | ⬆ | |
| 09-03-2009 | Application Is Considered Ready for Issue | ⬆ | |
| 08-28-2009 | Issue Fee Payment Verified | ⬆ | |
| 08-27-2009 | Petition Entered | | |
| 08-28-2009 | Issue Fee Payment Received | | |
| 07-16-2009 | Workflow - Drawings Finished | | 120 |
| 07-16-2009 | TC Return to Pubs | | ⬆ |
| 06-23-2009 | Receipt into Pubs | | ⬆ |
| 06-12-2009 | Receipt into Pubs | | ⬆ |
| 06-08-2009 | Sequence Forwarded to Pubs on Tape | | ⬆ |
| 05-28-2009 | Mail Notice of Allowance | | ⬆ |
| 05-25-2009 | Document Verification | | ⬆ |
| 05-25-2009 | Notice of Allowance Data Verification Completed | | ⬆ |
| 05-22-2009 | Examiner's Amendment Communication | | ⬆ |
| 04-25-2009 | Date Forwarded to Examiner | | ⬆ |
| 04-15-2009 | Response after Non-Final Action | | 90 |
| 04-15-2009 | Request for Extension of Time - Granted | | ⬆ |
| 10-15-2008 | Electronic Review | | ⬆ |
| 10-15-2008 | Email Notification | | ⬆ |
| 10-15-2008 | Mail Non-Final Rejection | | ⬆ |
| 10-09-2008 | Non-Final Rejection | | |
| 02-20-2008 | Information Disclosure Statement considered | | |
| 08-20-2008 | Date Forwarded to Examiner | | |
| 08-20-2008 | Date Forwarded to Examiner | | |
| 08-05-2008 | Request for Continued Examination (RCE) | | 92 |

Exhibit 2

| | | |
|------------|--|----|
| 08-20-2008 | Disposal for a RCE / CPA / R129 | ⬆ |
| 08-05-2008 | Request for Extension of Time - Granted | ⬆ |
| 08-05-2008 | Workflow - Request for RCE - Begin | ⬆ |
| 02-20-2008 | Information Disclosure Statement (IDS) Filed | ⬆ |
| 02-20-2008 | Miscellaneous Incoming Letter | ⬆ |
| 02-20-2008 | Information Disclosure Statement (IDS) Filed | ⬆ |
| 02-06-2008 | Electronic Review | ⬆ |
| 02-05-2008 | Email Notification | ⬆ |
| 02-05-2008 | Mail Final Rejection (PTOL - 326) | ⬆ |
| 01-31-2008 | Final Rejection | |
| 12-18-2007 | Email Notification | |
| 12-03-2007 | Mail Miscellaneous Communication to Applicant | |
| 11-29-2007 | Miscellaneous Communication to Applicant - No Action Count | |
| 10-31-2007 | Improper Request for Continued Examination | |
| 11-29-2007 | Date Forwarded to Examiner | |
| 10-31-2007 | Response after Non-Final Action | 76 |
| 10-31-2007 | Request for Extension of Time - Granted | ⬆ |
| 10-31-2007 | Workflow - Request for RCE - Begin | ⬆ |
| 05-17-2007 | Electronic Review | ⬆ |
| 05-16-2007 | Email Notification | ⬆ |
| 05-16-2007 | Mail Non-Final Rejection | ⬆ |
| 05-10-2007 | Non-Final Rejection | |
| 03-30-2007 | Date Forwarded to Examiner | |
| 03-30-2007 | Date Forwarded to Examiner | |
| 03-30-2007 | Date Forwarded to Examiner | |
| 03-28-2007 | Request for Continued Examination (RCE) | |
| 03-30-2007 | Disposal for a RCE / CPA / R129 | |
| 03-28-2007 | Workflow - Request for RCE - Begin | |
| 12-20-2006 | Mail Advisory Action (PTOL - 303) | |
| 12-18-2006 | Advisory Action (PTOL-303) | |
| 12-08-2006 | Date Forwarded to Examiner | |
| 11-28-2006 | Amendment/Argument after Notice of Appeal | |
| 11-28-2006 | Notice of Appeal Filed | 61 |
| 11-28-2006 | Request for Extension of Time - Granted | ⬆ |
| 06-28-2006 | Mail Final Rejection (PTOL - 326) | ⬆ |
| 06-26-2006 | Final Rejection | |
| 03-31-2006 | Miscellaneous Incoming Letter | |
| 03-31-2006 | Certified Translation of Foreign Priority Document | |
| 04-12-2006 | Date Forwarded to Examiner | |
| 03-31-2006 | Response after Non-Final Action | 59 |
| 03-31-2006 | Request for Extension of Time - Granted | ⬆ |

F. H. H. + 2

| | | | |
|------------|--|-----|---|
| 04-07-2006 | CRF Is Good Technically / Entered into Database | | ↑ |
| 10-31-2005 | Mail Non-Final Rejection | 305 | |
| 10-27-2005 | Non-Final Rejection | | ↑ |
| 02-12-2004 | Information Disclosure Statement considered | | ↑ |
| 10-11-2005 | IFW TSS Processing by Tech Center Complete | | ↑ |
| 10-11-2005 | Case Docketed to Examiner in GAU | | ↑ |
| 02-12-2004 | Reference capture on IDS | | ↑ |
| 02-12-2004 | Information Disclosure Statement (IDS) Filed | | ↑ |
| 02-12-2004 | Information Disclosure Statement (IDS) Filed | | ↑ |
| 02-12-2004 | Request for Foreign Priority (Priority Papers May Be Included) | | ↑ |
| 11-17-2004 | Application Return from OIPE | | ↑ |
| 11-17-2004 | Application Return TO OIPE | | ↑ |
| 11-17-2004 | Application Return from OIPE | | ↑ |
| 11-17-2004 | Application Is Now Complete | | ↑ |
| 11-17-2004 | Application Return TO OIPE | | ↑ |
| 11-17-2004 | Application Return from OIPE | | ↑ |
| 11-17-2004 | Application Is Now Complete | | ↑ |
| 11-17-2004 | Application Return TO OIPE | | ↑ |
| 11-17-2004 | Application Dispatched from OIPE | | ↑ |
| 11-17-2004 | Application Is Now Complete | | ↑ |
| 10-12-2004 | Additional Application Filing Fees | | ↑ |
| 10-30-2003 | Claim Preliminary Amendment | | ↑ |
| 08-13-2004 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | | ↑ |
| 10-12-2004 | Translation of Claims into English | | ↑ |
| 10-12-2004 | Applicant has submitted new drawings to correct Corrected Papers problems | | ↑ |
| 10-12-2004 | Translation of Specification into English | | ↑ |
| 08-11-2004 | Notice Mailed--Application Incomplete--Filing Date Assigned | | ↑ |
| 01-21-2004 | Cleared by OIPE CSR | | ↑ |
| 12-02-2003 | IFW Scan & PACR Auto Security Review | | ↑ |
| 10-30-2003 | Initial Exam Team nn | | ↑ |

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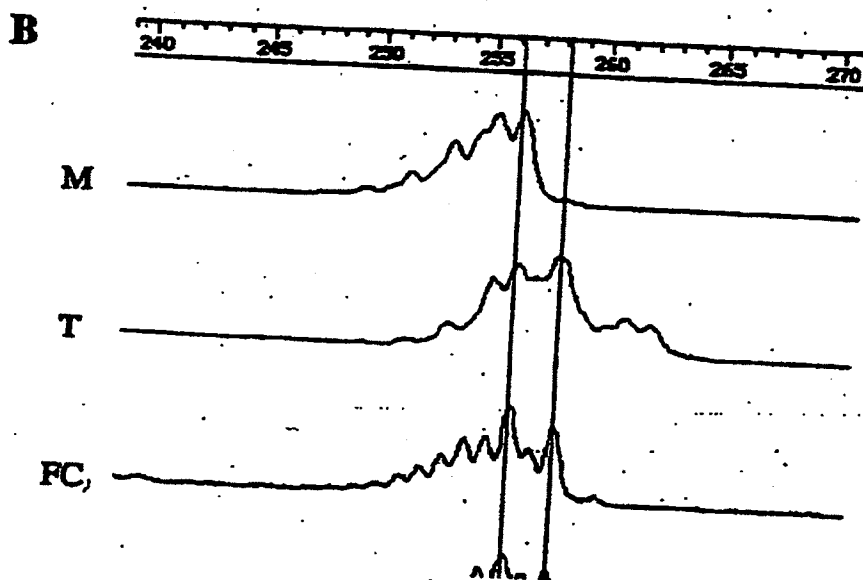
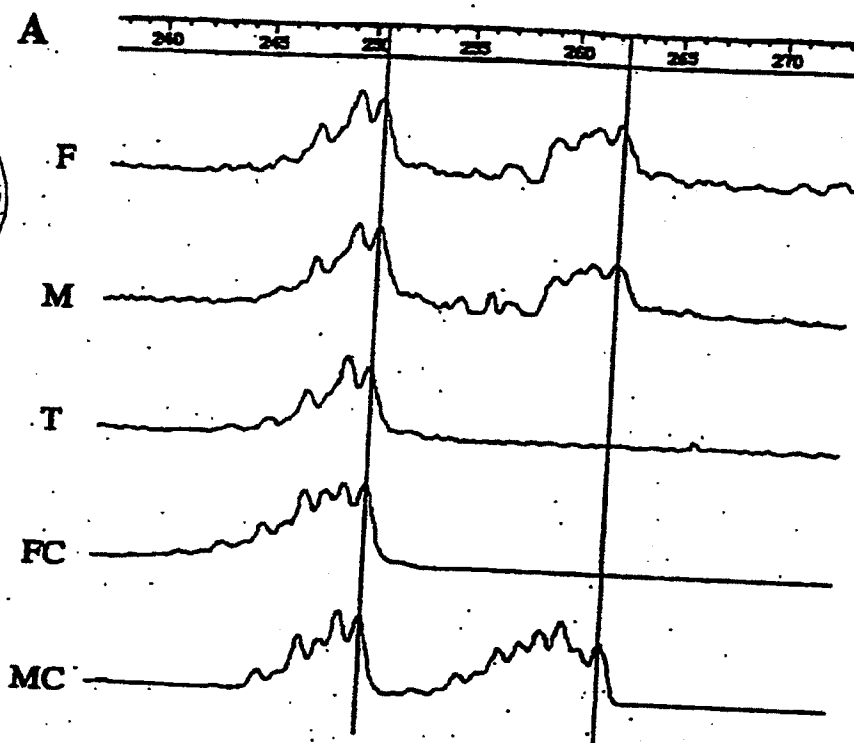


Figure 3

| | | |
|------------|---|----------------------|
| 10/695,744 | PRENATAL DIAGNOSIS METHOD ON ISOLATED FOETAL CELL OF MATERNAL BLOOD | 07-30-2009::15:36:04 |
|------------|---|----------------------|

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/695,744

| | | | |
|------------------------------|------------|--------------------------------------|-----|
| Filing or 371(c) Date: | 10-30-2003 | USPTO Delay (PTO) Delay (days): | 305 |
| Issue Date of Patent: | - | Three Years: | - |
| Pre-Issue Petitions (days): | +0 | Applicant Delay (APPL) Delay (days): | 378 |
| Post-Issue Petitions (days): | +0 | Total PTA (days): | 0 |
| USPTO Adjustment(days): | +0 | Explanation Of Calculations | |

Patent Term Adjustment History

| Date | Contents Description | PTO(Days) | APPL(Days) |
|------------|--|-----------|------------|
| 05-28-2009 | Mail Notice of Allowance | | |
| 05-25-2009 | Document Verification | | |
| 05-25-2009 | Notice of Allowance Data Verification Completed | | |
| 05-22-2009 | Examiner's Amendment Communication | | |
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| 04-15-2009 | Response after Non-Final Action | | 90 |
| 04-15-2009 | Request for Extension of Time - Granted | | ⬆ |
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| 10-09-2008 | Non-Final Rejection | | |
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| 08-20-2008 | Date Forwarded to Examiner | | |
| 08-20-2008 | Date Forwarded to Examiner | | |
| 08-05-2008 | Request for Continued Examination (RCE) | | 92 |
| 08-20-2008 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA) | | ⬆ |
| 08-05-2008 | Request for Extension of Time - Granted | | ⬆ |
| 08-05-2008 | Workflow - Request for RCE - Begin | | ⬆ |
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| 02-20-2008 | Miscellaneous Incoming Letter | | ⬆ |
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| 01-31-2008 | Final Rejection | | |
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| 12-03-2007 | Mail Miscellaneous Communication to Applicant | | |
| 11-29-2007 | Miscellaneous Communication to Applicant - No Action Count | | |
| 10-31-2007 | Improper Request for Continued Examination | | |
| 11-29-2007 | Date Forwarded to Examiner | | |
| 10-31-2007 | Response after Non-Final Action | | 76 |

EXHIBIT 4

| | | |
|------------|--|-----|
| 10-31-2007 | Request for Extension of Time - Granted | ⬆ |
| 10-31-2007 | Workflow - Request for RCE - Begin | ⬆ |
| 05-17-2007 | Electronic Review | ⬆ |
| 05-16-2007 | Email Notification | ⬆ |
| 05-16-2007 | Mail Non-Final Rejection | ⬆ |
| 05-10-2007 | Non-Final Rejection | |
| 03-30-2007 | Date Forwarded to Examiner | |
| 03-30-2007 | Date Forwarded to Examiner | |
| 03-30-2007 | Date Forwarded to Examiner | |
| 03-28-2007 | Request for Continued Examination (RCE) | |
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| 11-17-2004 | Application Return from OIPE | ⬆ |
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| 11-17-2004 | Application Return from OIPE | ⬆ |

| | | |
|------------|--|---|
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| 11-17-2004 | Application Return TO OIPE | ⌵ |
| 11-17-2004 | Application Dispatched from OIPE | ⌵ |
| 11-17-2004 | Application Is Now Complete | ⌵ |
| 10-12-2004 | Additional Application Filing Fees | ⌵ |
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| 08-13-2004 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | ⌵ |
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| 10-12-2004 | Applicant has submitted new drawings to correct Corrected Papers problems | ⌵ |
| 10-12-2004 | Translation of Specification into English | ⌵ |
| 08-11-2004 | Notice Mailed--Application Incomplete--Filing Date Assigned | ⌵ |
| 01-21-2004 | Cleared by OIPE CSR | ⌵ |
| 12-02-2003 | IFW Scan & PACR Auto Security Review | ⌵ |
| 10-30-2003 | Initial Exam Team nn | ⌵ |

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